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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/471,072	12/21/1999	EDUARDO PELEGRI-LLOPART	SUN1P254/P41	6969

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EXAMINER

KISS, ERIC B

ART UNIT	PAPER NUMBER
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2122

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/471,072

Applicant(s)

PELEGRI-LLOPART ET AL.

Examiner

Eric B. Kiss

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-12 have been examined.

Drawings

2. The drawings are object to because Figure 2 does not clearly illustrate the details of the second interface (indicated with the shorter of the two vertical bars). It is unclear whether this is intended to show a request object to container interface as described in page 2, lines 5-9 or a container to JSP Page interface as described in page 2, lines 10-12. Since the vertical bar representing this interface stops before reaching the "Container" label, it is not clear whether this label is to be assumed to lie to the right of this interface in the figure. It is furthermore unclear whether or not there is any significance in the ovals around "request" and "response" by the second interface.

Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

Specification

3. The use of trademarks JAVA and JAVASERVER have been noted in this application. They should be capitalized wherever they appears and be accompanied by the generic terminologies.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 1, 7, 11, and 12, disclose components or steps that do not fully achieve the results as stated in the preamble of each claim.

Art Unit: 2122

b. Claims 1 and 7 each recite the limitation “for each page” in line 3 and line 8, respectively, but the preambles of each claim recites “a page”, making it unclear whether more than one page is intended. In the interest of compact prosecution, references to “each page” are subsequently treated as reading “the page” for the purpose of further examination.

c. Claim 2 is rejected based on inherited parent claim limitations recited in claim 1 and rejected as set forth above in items (a) and (b).

d. Claim 3, recites the limitation “(run-time)”, which is not synonymous with the preceding term “executed”. Since the parenthetical term renders the scope of the claim indefinite and otherwise appears to be unnecessary, it is subsequently ignored for the purpose of further examination.

e. Claims 4, 6, 8, and 10 contain the trademark/trade names JAVA and/or JAVASERVER. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the

Art Unit: 2122

trademark/trade names are used to identify/describe specific programming language components and, accordingly, the identification/description is indefinite.

In the interest of compact prosecution, the “Java” adjective in claims 4 and 8 is subsequently interpreted as meaning based on Java™ technology—“an object-oriented, platform-independent, multithreaded, programming environment” (see “Java[tm] Technology Overview”, first paragraph), and “JavaServer Page” in claims 6 and 10 is subsequently interpreted as “a text-based document that describes how to process a request to create a response” as it is defined on page 1, lines 18-20 of the instant application.

f. Claims 5 and 9 each recite a negative limitation that relates to the operation of unclaimed features.

g. Claim 7 recites the limitation "for each action tag" in line 3. There is insufficient antecedent basis for this limitation in the claim. In the interest of compact prosecution, “a page” in the preamble to claim 7 is interpreted as if it reads “a page containing action tags” for the purpose of further examination.

h. Claims 11 and 12 recite the limitations "for each page" in lines 4, respectively and "for each action tag" in lines 6, respectively. There is insufficient antecedent basis for these limitations in the claims. In the interest of compact prosecution, “in a tag extension mechanism” in the preamble to claims 11 and 12 is interpreted as if it reads “between a page containing action tags and a tag library” for the purpose of further examination.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1 and 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1, merely claimed as a computer program representing a computer listing *per se* (mechanism), that is, descriptions or expressions of such a program and that is, descriptive material *per se*, non-functional descriptive material, and is not statutory because it is not a physical “thing” nor a statutory process, as there are not “acts” being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed aspects of the invention which permit the computer program’s functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a process, without the computer-readable medium needed to realize the computer program’s functionality. In contrast, a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer program and the medium which permit the computer program’s functionality to be realized, and is this statutory. **Warmerdam**, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(a).

Art Unit: 2122

As per claim 11, merely claimed as a “computer readable medium” that is mere arrangements or compilations of facts, information, or data *per se* and which is merely stored so as to be called “computer-readable” or even outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer (“acts”), then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Thus, such “descriptive material”, non-functional descriptive material, that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter. And the purely non-functional descriptive material cannot alone provide the practical application for the manufacture. **Warmerdam**, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(b).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by “Extensible Markup Language (XML) 1.0” (hereinafter XML).

As per claim 1, XML teaches a mechanism comprising a pageContext object containing a mapping of scripting variables to values (replacement text; see section 4.4 and corresponding subsections on pp. 20-22) and a TagExtraInfo object containing a method that returns a list of available scripting variables and a variable type associated with each variable (attribute-list declaration; see section 3.3 and corresponding subsections on pp. 13-15).

As per claims 2 and 3, XML further teaches a translator (XML processor) that consults the TagExtraInfo object (attribute-list declaration) to obtain the list of available scripting variables when the page is translated and further creating the pageContext object (replacement text) when the page is executed (see, for example, section 4.4.2 on p. 21 describing treatment by the XML processor of character data referenced in an attribute value according to the table in section 4.4).

10. Claims 1-3, 7, 11, and 12 are rejected under 35 U.S.C. 102(a) as being anticipated by the ColdFusion 4.0 software product, available at least as early as October 2, 1998, as evidenced by the ColdFusion Documentation files, including: “Getting Started with ColdFusion” (hereinafter CF Getting Started); “Developing Web Applications with ColdFusion” (hereinafter CF Web); “Advanced ColdFusion Development” (hereinafter CF Advanced); “ColdFusion 4.0 Documentation Update” (hereinafter CF Update); and “ColdFusion Quick Reference Guide” (hereinafter CF Guide), and such a product hereinafter ColdFusion 4.0.

Art Unit: 2122

As per claim 1, ColdFusion 4.0 is disclosed with a mechanism comprising a pageContext object containing a mapping of scripting variables to values (CFSET tag; see CF Web, pp. 16-17 section titled "Using CFSET to create variables") and a TagExtraInfo object containing a method that returns a list of available scripting variables and a variable type associated with each variable (see CF Advanced, p. 27 subsection titled "Ancestor data access" and, in particular, the description of the GetBaseTagData function).

As per claim 2, ColdFusion 4.0 is further disclosed with a translator (ColdFusion) that consults the TagExtraInfo object (evaluates the GetBaseTagData function) to obtain the list of available scripting variables (ancestor variables) when the page is translated (see CF Advanced, pp. 27-28 subsection titled "Example: Ancestor data access" and, in particular, see the fifth line of the code example).

As per claim 3, ColdFusion 4.0 is further disclosed with creating the pageContext object when the page is executed (see CF Web, p. 17 sections titled "Example: Dynamic parameters" and "Example: Expressions").

As per claim 7, this is a method version of the claimed mechanism discussed above (claims 1-3), wherein all claim limitations also have been addressed as set forth above.

As per claim 11, ColdFusion 4.0 is further disclosed with a computer readable medium including computer program code (ColdFusion CD-ROM; see CF Getting Started, p. 4 section titled "To install ColdFusion for Windows"), wherein all other limitations also have been addressed as set forth above.

As per claim 12, ColdFusion 4.0 is further disclosed with a computer system comprising a processor (see CF Getting Started, p. 3 section titled "Windows 95 and 98, and Windows NT"), wherein all other limitations also have been addressed as set forth above.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 4-6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the ColdFusion 4.0 software product as applied to claims 3 and 7 above.

As per claim 4, ColdFusion 4.0 is disclosed with such a TagExtraInfo object that comprises (as a function return value) an object name for each variable (variable name), a type for each variable (based on variable naming conventions; see, e.g., CF Advanced p. 28, lines 8-9 which determines the custom tag context by looking for a variable beginning with "CF_"), and a scope parameter for each variable (see CF Advanced, pp. 27-28 subsections titled "Ancestor data access" and "Example: Ancestor data access"), but is not disclosed with such a Java implementation. However, ColdFusion 4.0 suggests using the Java language to build extensions as an alternative to CFML (see CF Advanced, p. 13 introductory paragraph). Therefore, it would have been obvious to one having ordinary skill in the computer art at the time the invention was

Art Unit: 2122

made to modify the ColdFusion 4.0 implementation to include a Java version of the TagExtraInfo object. One would be motivated to do so to allow for easier customization and upgrading ability that a user-defined extension would provide.

As per claim 5, the tag library of ColdFusion 4.0 further does not know which scripting language is used to create the page (for example, CF Advanced, pp. 9-10 provide an example of a JavaScript object in addition to the normal HTML-only page without making any changes to the tag library). Therefore, such a claim also would have been obvious.

As per claim 6, ColdFusion is disclosed with a text-based document (CFML document) that describes how to process a request (evaluate functions and tag objects) to create a response (generate an HTML document) just as the JavaServer Page is described in the instant application (see p. 1, lines 18-20). Therefore, it would have been obvious to one having ordinary skill in the computer art at the time the invention was made to substitute the known (see, for example, "Tools for Developing Servlets and Server Pages Using Java Technology," 1999, JavaOne '99 Session Information) JavaServer Page technology for the ColdFusion 4.0 technology. One would be motivated to do so because both are directed toward the same function.

As per claims 8-10, these are method versions of the claimed mechanism discussed above (claims 4-6, respectively), wherein all claim limitations also have been addressed as set forth above. Therefore, such claims also would have been obvious.

Art Unit: 2122

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Kiss whose telephone number is (703) 305-7737. The examiner can normally be reached on Tue. - Fri., 7:30 am - 5:00 pm. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (703) 308-4789.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

Or faxed to:

(703) 746-7239 (for formal communications intended for entry)

Or:

(703) 746-7240 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

EBK
September 25, 2002



**TUAN Q. DAM
PRIMARY EXAMINER**